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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,306	10/21/2003	Stephen L. Ward	000850-11	8337

7590

10/20/2005

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EXAMINER

SMITH, MATTHEW J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,306

Applicant(s)

WARD ET AL.

Examiner

Matthew J. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-15, 17-26 and 28-37 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 16 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 21Oct03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-31, 33, 34, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (5842516).

Jones '516 discloses a method for placing gravel slurry with a tool having a screen 21, exit nozzle chambers 29, and base pipe (for packer 30) comprising providing unperforated flow conduits or shunt tubes 25 for radially spaced primary flow paths; filling the annulus with gravel slurry from the tube annulus through the chambers into the well annulus (col. 3, line 47); crossover sub 22; and gravel slurry return 31.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 18-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (5515915) in view of Jones (5842516).

Jones et al. '915 disclose base pipe 25 with openings 26; several permeable outer surface sections 30 stood off and over the base pipe that abates particulates and forms an annulus; exit port or outlets 33; shunt tube 28 interspersed with support rods 29; outer member or manifold 55 having an interior open to and facing the shunt tube plus forming an annulus for fluid flow; the support rods 29 and shunt tubes 28 welded to the outer surface (col. 4, lines 31-35); wire wrap sections 31; outlets 33 alternating with outer surface sections; gravel slurry introduced interior to tool 20 at the top concentric annulus 55; and slurry return 56 through the tool interior but not exit nozzle chambers.

Jones '516 presents exit nozzle chamber or insert 29 at outlets 26 in a screen and gravel slurry delivery tool.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the Jones '516 inserts 29 at the Jones et al. '915 outlets 33 in order to resist erosion and maintain diameter (Jones et al., col. 2, lines 1-2).

Claims 13-15, 17, 22, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (5515915) in view of Jones (5842516) and Gunnerood (20040140089).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Jones et al. '915 disclose base pipe 25 with openings 26; several permeable outer surface sections 30 stood off and over the base pipe that abates particulates and forms an annulus; exit port or outlets 33; shunt tube 28 interspersed with support rods 29; outer member or manifold 55 having an interior open to and facing the shunt tube plus forming an annulus for fluid flow; the support rods 29 and shunt tubes 28 welded to the outer surface (col. 4, lines 31-35); wire wrap sections 31; outlets 33 alternating with

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outer surface sections; gravel slurry introduced interior to tool 20 at the top concentric annulus 55; and slurry return 56 through the tool interior but not exit nozzle chambers or a coupling forming a manifold.

Jones '516 presents exit nozzle chamber or insert 29 at outlets 26 in a screen and gravel slurry delivery tool.

Gunneroed shows a coupling 13 forming a manifold in a screen and gravel slurry delivery tool.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the Jones '516 inserts 29 at the Jones et al. '915 outlets 33 and the Gunneroed coupling 13 in order to resist erosion and maintain diameter (Jones et al., col. 2, lines 1-2) and without having to align the shunt tubes on adjoining joints (Gunneroed, paragraph [0051]), respectively.

Claims 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5842516) in view of Gunneroed (20040140089).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Jones '516 discloses a method for placing gravel slurry with a tool having a screen 21, exit nozzle chambers 29, and base pipe (for packer 30) comprising providing unperforated flow conduits or shunt tubes 25 for radially spaced primary flow paths and filling the annulus with gravel slurry from the tube annulus through the chambers into the well annulus but not round conduits or seal.

Gunneroed shows a round conduit (fig. 3E) and seal 31 in a screen and gravel slurry delivery tool.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a round conduit and seal, as shown by Gunneroed, in the Jones '516 tool in order to indicate a preference (Gunneroed paragraph [0046]) and minimize back flow, respectively.

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Claims 28 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (5842516) in view of Jones (5515915).

Jones '516 discloses a method for placing gravel slurry with a tool having a screen 21, exit nozzle chambers 29, and base pipe (for packer 30) comprising providing unperforated flow conduits or shunt tubes 25 for radially spaced primary flow paths; filling the annulus with gravel slurry from the tube annulus through the chambers into the well annulus; and gravel slurry return 31 but not gravel slurry through the top annulus.

Jones '915 depicts gravel flowing through the top annulus via manifold 55 in a screen and gravel slurry delivery tool.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the Jones '915 system to allow gravel slurry through a top annulus, as depicted by Jones '915, in order to provide necessary alternate flow paths without substantially increasing overall screen outside diameter (Jones et al. '915, col. 2, lines 62-64).

Allowable Subject Matter

Claims 11, 12, 16, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicants' arguments filed 12 July 2005 have been fully considered but they are not persuasive. The examiner contends Jones '516 pumps slurry through exit nozzles or outlets 26. With regard to the Jones '516 nozzle chamber, the argument is not convincing. The structure set forth by applicants' 27. This recess performs the same function as applicants' chamber 6, noting the Jones' 516 discussion of figures 3-7, column 4, lines 46-67.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS *MJS*
5 October 2005